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10/001,662	10/18/2001	Thiru Srinivasan	1585C (42059-01380)	4124

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/001,662

Applicant(s)

SRINIVASAN ET AL.

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-6,8-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6,8-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Objections***

Claim 2, 10, and 15 are objected to because the recitations "to to" and "may b" are grammatically improper while claim 15 appears to have no dependency and is not drafted in independent form. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

Claims 1-6, 8-11, 13-19, and 21 are rejected under 35 U.S.C. 101 because the claimed method of broadcasting multimedia information does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed detecting, identifying, broadcasting, using, and retrieving contain recitations of descriptive material that cannot exhibit any functional interrelationship with the way in which computing process are performed and does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. Furthermore, each feature is not directed to statutory subject matter that falls within the technological arts such that the claimed invention is not required to have structural interaction with a machine. Each of the independently claimed features can be performed by a human without any structural or mechanical interaction (i.e. a messenger person could act as a broadcast server while the recipients of the messengers information could be performed by face to face communications also known as the claimed data network by verbally transmit an appropriate commercial to

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the listeners for aural receipt during the song and dance break). Since the dependent claims are depending upon non-statutory subject matter, those claims are also rejected. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, and the claimed invention does not require physical interaction with any type of structure, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. Claims 13-19 and 21 are system claims dependent upon a method. The subject named statute provides for patenting of a method or process and for patenting of a machine or system, but not both. It is considered that claims 13-19 and 21 are an attempt to obtain a patent on separate statutory categories. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 112***

Claims 1-6, 8-19, and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claimed features including:

- detecting a commercial break during broadcasting of multimedia information;
- based on the demographic information retrieved for at least one system user,
- identifying an appropriate commercial; and

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transmitting the appropriate commercial to the at least one system user during the commercial break; along with

a second memory accessible by the server upon which is stored commercial which are transmittable to the at least one system user wherein the server is further configured to selected and transmit at least one appropriate commercial based on retrieved demographic information for at least one system user during at least one detected commercial break are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention because those steps are not described in the specification such that those skilled in the art would be reasonably conveyed that the inventor had possession of the inventive concept. Furthermore, the independently claimed "appropriate" feature is not enabling and is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. However in order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter.

Claims 1-6, 8-19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed features including:

detecting a commercial break during broadcasting of multimedia information;

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based on the demographic information retrieved for at least one system user, identifying an appropriate commercial; and

transmitting the appropriate commercial to the at least one system user during the commercial break; along with

a second memory accessible by the server upon which is stored commercial which are transmittable to the at least one system user wherein the server is further configured to selected and transmit at least one appropriate commercial based on retrieved demographic information for at least one system user during at least one detected commercial break fail to particularly point out and distinctly claim the subject matter which applicant because that feature is indefinite from the accepted definitions to those skilled in the art and lacks an antecedent basis from the specification. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include "the data network" - multiple occurrences (claims 1 and 2), "the memory" (claims 1 and 10), "the demographics" (claim 1) "the network server" (claims 2, 9, and 11), "the commercial" - singular first occurrence (claims 2 and 12), "the step" (claims 4, 5, 6, 9, 10, and 11), "the time" (claim 6), "the at least one system user's response" (claim 10), "the interactive component" (claim 10), "the IP address" (claim 11), "the one or more system user" (claim 12), "the commercial" – singular first occurrence (claim 12), "the World Wide Web" (claim 13), "the detected commercial breaks" - plural first occurrence (claim 16), "the appropriate commercials" – plural first occurrence (claim 19), "the commmericals" – plural first occurrence, "the interactive element" – singular first occurrence, and "the

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second" (claim 21). Finally, the claimed "appropriate" feature is indefinite and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However in order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

***Claim Rejections - 35 USC § 102***

Claims 1-6, 8-19, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cogswell et al. (US 4,331,974), Wachob (US 5,155,591), Wilkins (US 5,446,919), Carles (US 5,515,098 or US 5,661,516), or Hendricks et al. (US 5,600,364), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Meyer et al. (WO 99/46708), Rangan et al. (US 6,006,265), Herz et al. (US 6,020,883), Miller et al. (WO 00/17775), or Eldering (US 6,298,348).

***Claim Rejections - 35 USC § 103***

Claims 1-6, 8-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of NFL Super Bowl advertising information (hereinafter NFL) over a network. Since at least 1990, NFL has performed the claimed method and system of broadcasting multimedia information over a data network comprising:

detecting at least one system user connected to receive multimedia information or a device connectable to the data network to which at least one system user may

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connect, wherein the device is configured to broadcast multimedia to the at least one system user over the data network;

identifying the at least one system user connected to the broadcast server and accessing at least one database to retrieve demographic information for the at least one system user or a first memory configured to store identification stored in first memory and demographic information for the at least one system user;

broadcasting the multimedia information over the data network to the at least one system user or said device is further configured to extract the identification information for the at least one system user upon establishment of the connection, which is then employed to search the at least one memory to locate demographic information; and

detecting a commercial break during broadcasting of the multimedia information and based on the demographic information retrieved for the at least one system user, identifying an appropriate commercial;

using the retrieved demographic to identify at least one commercial stored in memory associated with the demographics for the at least one system user; and

retrieving the at least one commercial from memory and broadcasting the retrieved commercial to the at least one system user during the commercial break or a second memory accessible by the server upon which is stored commercials which are transmittable to the at least one system user wherein the server is further configured to select and transmit at least one appropriate commercial based on the retrieved demographic information for the at least one system user during the at least one detected commercial break. Examiner also has personal experience of the claimed

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method and system of broadcasting multimedia information over a data network including the features: different users, live programming, monitoring and creating demographic information, ad hoc commercial breaks, time based and identification demographic analysis, database information retrieval and query of demographic information, interactive elements and plurality programming. Examiner considers the claimed data network to be substantially patentably equivalent as an obvious variation to a television network, the claimed broadcasting multimedia information to be the television showing of the NFL, the claimed at least one system user to be an NFL viewer, and the claimed device to be a television. This examiner consideration of terms is used to reasonably interpret the claims in light of examiner's personal experience. The claimed detecting at least one system user connected to receive multimedia information or a device connectable to the data network to which at least one system user may connect, wherein the device is configured to broadcast multimedia to the at least one system user over the data network occurs when advertising agencies would purchase commercial breaks for the NFL. The claimed identifying the at least one system user connected to the broadcast server and accessing at least one database to retrieve demographic information for the at least one system user or a first memory configured to store identification stored in first memory and demographic information for the at least one system user occurs when the advertising agencies would target advertisements toward viewers of the Super Bowl for the NFL. The claimed broadcasting the multimedia information over the data network to the at least one system user or said device is further configured to extract the identification information

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for the at least one system user upon establishment of the connection, which is then employed to search the at least one memory to locate demographic information is merely the television station showing of the Super Bowl and NFL based on advertising agencies gathering data from common demographic information gathering agencies such as Nielsen ratings or Gallop polls. The claimed detecting a commercial break during broadcasting of the multimedia information and based on the demographic information retrieved for the at least one system user, identifying an appropriate commercial and using the retrieved demographic to identify at least one commercial stored in memory associated with the demographics for the at least one system user; and retrieving the at least one commercial from memory and broadcasting the retrieved commercial to the at least one system user during the commercial break is merely how the advertising agencies and television stations work together to show Super Bowl advertisements. NFL has provided the claimed invention, recited by the applicant, long before the filing of applicants' invention except for the claimed server, Internet, and IP address or login ID. The claimed features including different users, live programming, monitoring and creating demographic information, ad hoc commercial breaks, time based and identification demographic analysis, database information retrieval and query of demographic information, interactive elements and plurality programming are so old and well known to those who have ever viewed television as a member or a targeted marketing demographic group have performed the claimed invention such that the examiner will use Official notice to obviate that claimed subject matter. Examiner notes that it is old and well known to those skilled in the art of providing advertising

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information over a network, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to the claimed server, Internet, and IP address or login ID since those features are merely an automated feature of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

Applicants admit that monitoring demographic information using Nielsen or Arbitron ratings for television and radio multimedia information broadcasting is old and well known as discussed in the background of the invention of the specification. The motivation to combine applicants claimed invention with the examiner's personal experience of NFL is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

### ***Double Patenting***

Claims 1-6, 8-19, and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over applicants' earlier patent US 6,411,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application claims a broader obvious

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variation of the patented claimed invention without the narrower features including creating a programming schedule and identifying commercial breaks (this feature is not claimed in the present application). Both the present application and the patented invention perform the same function in the same manner with the same result but using different obviousness terminology.

### ***Response to Arguments***

Applicant's arguments filed July 7, 2003 have been fully considered but they are not persuasive.

### ***Non-statutory subject matter***

The claims have been amended to overcome the subject named rejection, but as discussed in the rejection above, the rejection is maintained for the reasons stated in the rejection.

### ***Enablement and indefiniteness***

The specification and claims are not considered to have adequate nexus such that the claims can be easily understood by those skilled in the art. The specification discuss manipulation and transmission of information, but this discussion is not considered adequate to claim the features of broadcast of identified appropriate commercials such that a patent may be granted for the claimed invention.

*Anticipation*

It is considered that each of the cited references used in the rejection clearly anticipate the claimed invention because on each reference face, the claimed invention is disclosed.

*obviousness*

Applicants arguments are considered, but the features argued are not claimed. Claim limitations can not be supported by arguments or specification. Patentability is determined by claim language. It is considered that the claim language does not distinguish the claimed invention from examiner's experience of the prior art.

***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. If **applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.**

Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325

  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

Smg  
8/19/03